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MAR 14 2008

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(For Requester)

In re Reissue Application
of Yousheng Shen, et al.
Application No. 10/621,637
Filed: July 17, 2003
For: U.S. Patent No. 5,650,054

DECISION, *SUA SPONTE*,
TO MERGE
REISSUE AND
REEXAMINATION
PROCEEDINGS

In re Yousheng Shen, et al.
Reexamination Proceeding
Control No. 90/006,209
Filed: January 29, 2002
For: U.S. Patent No. 5,650,054

The above-captioned reissue and reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.565(d) at this time.

REVIEW OF FACTS

1. U.S. patent No. 5,650,054 (the '054 patent) issued on July 22, 1997, with 65 claims.
2. A request for reexamination was filed by a third party requester on January 29, 2002, and was assigned control No. 90/006,209 (hereinafter, the '209 proceeding).
3. Reexamination was ordered for the '209 proceeding on April 12, 2002.

4. An application for reissue, assigned application No. 10/621,637 (the '637 application), was filed by the patent owner on July 17, 2003. The Reissue Application Declaration by Assignee did not identify (i) the residence (e.g. city and either state or foreign country) of each inventor; (ii) the citizenship of each inventor; and (3) whether the inventor is a sole or joint inventor, as is required under 37 CFR 1.63.
5. On July 17, 2003, a Statement Under 37 CFR 1.178(b) was filed by the patent owner in the '637 application, notifying the Office of the '209 proceeding.
6. On July 18, 2003, a Statement Under 37 CFR 1.565(a) was filed by the patent owner in the '209 proceeding, notifying the Office of the filing of the '637 application.
7. A patent owner's statement under 37 CFR 1.530 has not been received in the '209 proceeding, and the time for filing same expired.
8. On October 8, 2003, the Office mailed a Notice of Informal Application. The Notice states that the '637 application is considered to be informal, because the Declaration filed on July 17, 2003 did not comply with 37 CFR 1.63, as noted above in item 4. The image file wrapper (IFW) on the Office's public Patent Application Information Retrieval (public PAIR) includes an electronic copy of the Notice under the document description "re-exam Formalities Notice."
9. The filing of the '637 application was announced in the *Official Gazette* on November 11, 2003.
10. In the '209 proceeding, prosecution advanced to the point that a final Office action was issued on December 16, 2002. In response to the final Office action, the patent owner filed an Appeal Brief on April 21, 2003, in the '209 proceeding. The Board issued a Decision on Appeal on March 28, 2007, in which the Board affirmed-in-part and entered new grounds of rejection. The patent owner filed on May 29, 2007, a Request to Reopen Prosecution Under 37 CFR 41.50(b)(1) accompanied by an Amendment and a

Supplemental Declaration of Commercial Success Under
37 CFR 1.132.

11. An Office action on the merits has not been issued in the '637 application.
12. On October 11, 2007, the Office issued a Show cause order as to why the '637 application should not be terminated. The show cause order gave patent owner thirty days to either show cause as to why the Reissue proceeding should not be terminated or in the alternative provide a grantable petition for entry of belated papers under 37 CFR 1.137.
13. On November 8, 2007, patent owner timely filed a response to the October 11, 2007 show cause order, including a petition for revival under 37 CFR 1.137(b).
14. On December 12, 2007, the Office issued a decision granting patent owner's petition to revive the '637 reissue application.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d) :

"If a reissue application and an ex parte reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings."

As set forth in the above Review of Facts, the '637 application and the '209 proceeding are currently pending. The order to reexamine has been mailed in the '209 proceeding, and notice of the '637 application has been published in the *Official Gazette*. Accordingly, a decision under 37 CFR 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately, and at the same time, as to a particular patent. The reason for this policy is to prevent inconsistent, and

possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether to merge the two proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

As also set forth in the above Review of Facts, prosecution will begin anew in the '209 proceeding, in view of the filing on May 29, 2007, of a Request to Reopen Prosecution Under 37 CFR 41.50(b)(1). The '637 application has been revived and, prosecution on the merits has yet to begin in the '637 application. Therefore, the '209 proceeding and the '637 application can be examined at the same time. Still further, in order to provide efficient and prompt handling and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate for the '637 application and the '209 proceeding to be merged, and for a joint examination to be conducted. Accordingly, the examination of the '637 application and the '209 proceeding will be merged in accordance with the decision set forth below.

It is to be noted, however, that the grant of merger of a reissue application and an *ex parte* reexamination proceeding under 37 CFR 1.565(d) **is discretionary**. *The present merger is not an assurance that, in a future similar situation, merger would be ordered.*

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-identified reissue application and reexamination proceeding (i.e., the '637 application and '209 proceeding) are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

1. The patent owner is required to maintain identical amendments in the reissue application and the

reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the reissue application and reexamination proceeding remain merged. See 37 CFR 1.565(d).

2. A review of the file for the '209 reexamination proceeding shows:
 - (a) Original patent claims 1-65 are present.
 - (b) Original claims 1 and 52 were amended on June 4, 2007.
 - (c) New claims 66 and 67 were added on October 10, 2002, and new claim 66 was amended on June 4, 2007.
3. A review of the '637 application shows:
 - (a) Original patent claims 1-65 are present.
 - (b) New claims 66-75 were added on July 17, 2003.
4. Accordingly, the claims are not identical in both proceedings.
5. An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision, placing the same amendments in both proceedings, specifically, Application No. 10/621,637 and Control Number 90/006,209. The response to this requirement must be limited to formally placing the same amendments in all cases, and patent owner must **not** address any issue of patentability in the housekeeping amendment. It is to be noted that, pursuant to MPEP 2285, amendments in a merged reexamination/reissue proceeding are submitted under 37 CFR 1.173, in accordance with reissue practice.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceedings

1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action for the merged proceeding.
2. In the event that a housekeeping amendment is not timely submitted to place the same changes in both proceedings, any claim which does not contain identical text in both proceedings should be rejected under 35 USC 112, second paragraph, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.
3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 USC 305 relating to the conduct of *ex parte* reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue-application examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. **However, periods for response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in *ex parte* reexamination (35 USC 305).**
4. Each Office action issued by the examiner will take the form of a *single action* that jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data *for both of the cases, i.e.,* the reissue application and the reexamination proceeding, and each action will be entered into both files (which will be maintained as separate files).
5. Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry in the two files, with each of the two bearing a signature. Any such response must contain identifying data *for both of the cases, i.e.,* the reissue application and the reexamination proceeding. *Any such responses must be*

served on the requester, who will also be sent copies of Office actions.

6. Pursuant to MPEP 2285, for a merged proceeding containing a reexamination proceeding and a reissue application:

"Amendments should be submitted in accordance with the reissue practice under ... 37 CFR 1.173; see MPEP 1453."

Thus, the filing of any amendments to the specification, claims, or drawings must comply with the provisions of 37 CFR 1.173, and with the guidelines of MPEP 1453. It is to be noted that 37 CFR 1.121 does not apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, and *such clean copies are not to be submitted*. Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. *Amendments are not to be made relative to previous amendments*. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

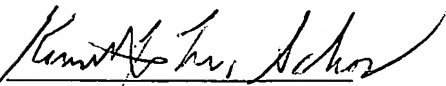
7. Where a paper is filed which requires payment of a fee (e.g., petition fee, excess claims fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner appeal brief, even though such a brief would relate to the merged multiple proceedings, and even though copies must be filed (as pointed out above) for each file of the merged proceeding.
8. The examiner (a) will review the files to ensure that each file contains identical citations of prior patents and printed publications, and (b) will cite such documents as

are necessary as part of the next Office action in order to place the files in that condition.

9. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be concluded by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 CFR 1.570. See MPEP 2285.
10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be dissolved. The reissue application will be held abandoned. The reexamination prosecution will be terminated, and a reexamination certificate under 37 CFR 1.570 will be issued in accordance with the last action of the Office, unless further action in the reexamination proceeding is needed as a result of the difference in the rules relating to reexamination and reissue proceedings. If further action in the reexamination proceeding is needed, any grounds of rejection that are not applicable under reexamination would be withdrawn (e.g., based on public use or on sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner, upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper for consideration in reexamination pursuant to 37 CFR 1.552(c).
11. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Such examination would be conducted as set forth in the immediately preceding paragraph.

CONCLUSION

1. Reissue application No. 10/621,637 and reexamination control No. 90/006,209 are merged into a single proceeding.
2. Pursuant to Part II of this decision, a **housekeeping amendment is required** within **ONE MONTH** of this decision, placing the same amendments in both cases of the present merged proceeding.
3. Jurisdiction over the merged reissue and reexamination proceeding is being transferred to Technology Center 1700, in which the reissue proceeding is assigned. The examiner assigned the merged proceeding is not to be one who was involved in any part of the examination of the '054 patent (e.g., by preparing/signing an action). See MPEP 2236.
4. The examiner should not issue an Office action for the present merged proceeding until after the earlier of: (a) the submission of the required housekeeping amendment to place the same amendments in both cases, or (b) the expiration of the ONE MONTH period from the mailing of this decision for filing the amendment.
5. All further examination in the merged proceeding should be conducted in accordance with Part III of this decision.
6. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr, Legal Advisor, at (571) 272-7759.



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